

II. REMARKS

Claims 1, 7, 12, and 17 were amended to more clearly define the subject matter of the invention and thereby place all of the claims remaining in the application in condition for allowance. Claims 6, 11, and 16 have been cancelled. Claims 4, 9, 14, and 18-20 have been withdrawn with traverse as a result of an earlier restriction requirement. Thus, claims 1-5, 7-10, 12-15, and 17-20 are pending in the present application. No new matter was presented and such amendments are deemed unobjectionable. Entry thereof is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

A. Claim Objections

Claim 5 depends from Claim 1 and was objected to as lacking proper antecedent basis for the element "said base". The current amendment to Claim 1 corrects the lack of antecedent basis. Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the objection.

B. Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, and 6 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Patent 2,820,256 to Dahl (hereafter "Dahl"). Applicant respectfully asserts that the rejection of claims 1, 2, and 6 is now moot in view of the amendment to claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, and 6 under 35 U.S.C. § 102 is respectfully requested.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the claimed invention is distinguishable over the cited reference and, thus, the cited reference fails to anticipate the claimed invention.

With respect to the rejection of independent claim 1, the Dahl reference fails to disclose each and every element as arranged in claim 1. Applicant independent claim 1 recites, *inter alia*, a base and a loop enclosure circumscribing the base.

Nowhere in the Dahl reference is there any disclosure regarding a base, much less a base that is circumscribed by a loop enclosure. Independent claim 1 is thereby distinguishable over the Dahl reference, which therefore cannot anticipate independent claim 1.

Based upon the above argument, Applicant respectfully submits that the Dahl reference does not disclose each and every element arranged as in claim 1 of Applicant independent claims. Therefore, in applying the test for anticipation as set forth above in *Lindemann*, Dahl does not anticipate independent claim 1. Further, under principles of claim

dependency and for at least the reasons stated above, Dahl does not anticipate any of the dependent claims either. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, and 6 under 35 U.S.C. § 102 is respectfully requested.

C. Claim Rejections Under 35 U.S.C. § 103

The Office Action rejected claims 3, 5, 7, 8, 10-13, and 15-17 under 35 U.S.C. § 103 as being unpatentable over Dahl in view of the teachings of U.S. Patent 4,380,836 to Braxton (hereafter “‘836 patent”). Applicant respectfully traverses each of the 35 U.S.C. § 103 rejections set forth herein for the reason that Applicant invention is patentably distinguishable, and not an obvious improvement, over the cited references.

1. Incomplete Obviousness Rejection

The Office Action does not present a complete obviousness rejection. According to MPEP § 706.02(j), a complete obviousness rejection requires an Office Action to set forth the following:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied references;
- (C) the proposed modification of the applied references necessary to arrive at the claimed subject matter; and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

Here, the Office Action fails to set forth the motivation to make the proposed modification and, therefore, the Office Action does not adequately communicate the basis

for the obviousness rejection such that Applicant has not been given a full and fair opportunity to develop a reply. As such, it is respectfully asserted that the Office Action but does not clearly and fully explain the rationale for the obviousness rejection. Therefore, Applicant respectfully asserts that it would be improper to make final any subsequent Office Action since the Applicant has not been entitled to a full and clear explanation for the obviousness rejection.

2. No *Prima Facie* Case of Obviousness

The Office Action has failed to set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness according to MPEP § 706.02(j), the cited references must teach or suggest all of Applicant's claim limitations, and there must be some suggestion or motivation to modify a reference or to combine reference teachings.

Prior to discussing the unobviousness of the present invention over the cited references, the problems, teachings, and disclosure of each of the cited references and Applicant's invention will be set forth.

Dahl discloses a collapsible enclosure having four upright side walls each including a pair of wall sections on opposite sides of a central dividing line that extends transversely around the enclosure. The side walls are foldable relative to each other along their vertical edges and the wall sections are foldable along the central dividing line to form a compact stack of eight wall sections. Two adjacent sections of two adjacent side walls are detachable with respect to one another and are respectively at opposite sides of the stack and are interconnected by a double hinge of a width sufficient to extend across the thickness of six intermediate wall sections of the stack. The remaining wall sections are interconnected by transverse hinges.

The '836 patent teaches a portable toilet shelter that can be broken down into base members including a commode floor member, folded wall sections, and roof members. The wall sections are vertically hinged so that side panels thereof can swing inwardly to allow front and back panels to collapse toward each other, thereby sandwiching the side panels therebetween to collapse to a thickness of about four walls.

Applicant's invention is directed to a portable toilet shelter that is more stackable and easier to assemble and disassemble than the prior art, including Dahl and the '836 patent. The portable toilet shelter includes a loop enclosure that is mountable to a base, and that is adapted to receive a roof. The loop enclosure includes opposed end walls each having opposed edges. Opposed side walls are positioned between the opposed end walls, with each of the side walls also having opposed edges. Flexible hinges connect the edges of the side walls to respective adjacent edges of the end walls to complete the loop enclosure. The portable toilet shelter is partially disassembled when collapsed to a height of about the thickness of two walls, wherein the end walls fold respectively toward and overlay the side walls.

a. Missing Elements

Foremost, it is apparent that the cited references do not teach all of Applicant claim limitations. Even assuming, *arguendo*, that there is a suggestion or motivation to combine the cited references, there are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that all of the claim limitations of Applicant invention are not met by Dahl or the '836 patent or any combination thereof.

Applicant independent claims recite, *inter alia*, a base, a loop enclosure circumscribing the base, and the loop enclosure being collapsible to a final folded flat state having a thickness of about two of the walls thereof.

The Office Action generally alleges that Dahl suggests the claimed invention of Applicant's independent claims, except for a base and a roof, which the Office Action further alleges is disclosed by the '836 patent. The Office Action also alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to "provide Dahl with a base and roof of '836, or to provide the '836 with the folding scheme of figure 2 of Dahl" (Office Action page 2).

The Applicant respectfully disagrees with the above allegations because there are significant structural and functional differences between Applicant invention and Dahl, or the '836 patent, or any combination thereof. Both cited references fail to disclose, teach, or suggest a loop enclosure collapsed to a final folded flat state having a thickness of about two of the walls thereof. Rather, the '836 patent teaches that the enclosure collapses to a final folded flat state having a thickness of about four of the walls thereof (Fig. 3). Similarly, the Dahl patent teaches use of a double hinge 40, 55, that prevents the enclosure from having a final folded flat state, much less having a thickness of about two of the walls thereof. The double hinge 40, 55 projects upwardly and thus does not enable the enclosure to fold to a flat state having a thickness of about two of the walls thereof, and thereby prevents multiple enclosures from being stacked flat atop one another. This is because the Dahl enclosure is not meant to fold flat to a thickness of about two of the walls thereof. Rather, Dahl teaches use of the double hinge 40, 55 to enable the Dahl enclosure to fold to a flat state having a thickness of eight of the wall sections (col. 3, lines 1-3). Thus, not only do Dahl and the '836

patent not meet all of Applicant claim limitations, the Dahl and '836 patent references essentially teach the opposite of Applicants. As stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, the claimed invention is distinguishable over the combination of cited references. (MPEP § 2145)

Therefore, even if the combination as suggested by the Office Action were legally justified, Applicant claims would still have novel and unobvious physical features over the proposed combination. In other words, any attempt at modifying or combining the cited references does not disclose all of the claimed features of Applicant invention and, therefore, the combination would necessarily constitute a different structure and different result than the claimed invention.

b. No Basis to Combine the Cited References

One of ordinary skill in the art would have no basis for combining the teachings of Dahl and the '836 patent in order to attempt to replicate Applicant invention, because there is no suggestion or motivation in the art to do so. It is well settled patent law that a sustainable obviousness rejection requires "some teaching, suggestion, or motivation to combine the references," as summarized by *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The initial burden to point out the suggestion in the prior art for the desirability of doing what the inventor has done, is on the Examiner. (MPEP § 706.02(j)) More specifically, the Examiner must set forth the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

Here, the Office Action lacks a proper prima facie showing of obviousness since the Office Action does not provide any suggestion for the desirability for the proposed combination, other than “both teach identical art devices”. (Office Action page 2) The fact that both references teach use of enclosures is not, by itself, sufficient to selectively substitute parts of one reference for a part of another to meet Applicant novel invention as claimed. Moreover, the Office Action does not set forth any principle or specific understanding within the level of ordinary skill in the art that would have motivated a skilled artisan to even attempt to combine the cited references. The conclusory assertion that it would have been prima facie obvious to employ the “perfecting features” (Office Action page 2) of one reference in the environment of the other does not amount to the required explanation of why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. Applicants respectfully submit that the Office Action’s lack of an indication anywhere in the record of a finding in the cited references of a suggestion for the desirability of the proposed combination, militates against an obviousness rejection of Applicant invention as claimed.

Regardless of the lack of a proper suggestion in the Office Action, the cited references themselves contain no suggestion whatsoever for combining the references to teach the invention as claimed according to Applicant disclosure. In other words, there is nothing in the references alone or together that suggest the claimed invention as a solution to the problem of flat as possible stackability of enclosures and, in fact, Applicant had to invent a solution to that problem. In fact, Applicant teachings are directed to a problem not even recognized in the cited references when considering all the cited references singularly or collectively. Not a single applied reference mentions the problems associated with

enclosures that are not optimized for flat stackability. Significantly, Applicant specifically identified the four-wall thickness of the collapsed enclosure of the '836 patent as a problem to be solved. The Dahl enclosure teaches a collapsed enclosure having a thickness of eight walls – twice as great as that of the '836 patent. Therefore, absent a recognition of the problem identified by the Applicant, it would be impossible for its solution to be obvious to any one, and the cited references cannot possibly suggest, singularly or in combination, a solution as novel as Applicant invention.

Notably, the Office Action fails to propose any specific modifications of each of the Dahl and '836 patent references that would be necessary to successfully combine the references to arrive at the claimed subject matter. Applicants assert that this failure is evidence that such a combination is not reasonably desirable or feasible, which militates against the obviousness rejection of Applicant invention.

The Office Action does, however, conclusively set forth that it would have been obvious to combine the references. But, the mere fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish a *prima facie* case of obviousness. (See MPEP § 2143.01) Similarly, just because one of ordinary skill in the art could rearrange parts of a referenced device to meet the terms of the claims is not, by itself, sufficient to support a finding of obviousness. The cited reference must provide a motivation, without the benefit of reading Applicant disclosure, to make the change in the referenced device. (See MPEP § 2144.04). Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Office Action include, in accordance with MPEP § 706.02, a specific and substantiated factual basis to support the conclusion that it would have been obvious to combine the references.

In view of a lack of a suggestion from the Office Action and from the cited references, a person of ordinary skill in the art would not seek to combine these references cited in the Office Action to produce the results that Applicant invention teaches. It is only through Applicant own teachings and disclosure that one of ordinary skill in the art would appreciate the need for a portable toilet shelter having a base, a loop enclosure circumscribing the base, wherein the loop enclosure is collapsible to a final folded flat state having a thickness of about two of the walls thereof. In other words, but for Applicant disclosure, there is no teaching, suggestion, or motivation whatsoever to combine Dahl and the '836 patent in any way in order to obviate Applicant invention. Accordingly, Applicant respectfully asserts that the Office Action is an example of hindsight reconstruction in an attempt to obviate Applicant invention after having the benefit of reading Applicant disclosure. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the cited references to deprecate the claimed invention. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Applicant invention is thus an unobvious improvement over the cited references and not an obvious modification or combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references discloses, teaches, or even suggests a portable toilet shelter having a base, a loop enclosure circumscribing the base, and the loop enclosure being collapsible to a final folded flat state having a thickness of about two of the walls thereof. Thus, independent claims 1, 7, 12, and 17 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, Dahl and the '836 patent do not render

Appl. No. 10/034,720
August 11, 2003
Reply to Office Action of April 11, 2003

PATENT

obvious any of the dependent claims either. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

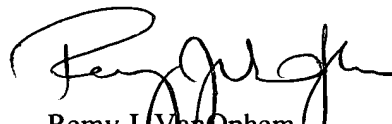
III. CONCLUSION

In view of the foregoing remarks, the Applicant respectfully submits that the pending independent and dependent claims are in proper form, define patentably over the cited references, and are all allowable. Applicant, therefore, respectfully requests that the Examiner's objections and rejections under 35 U.S.C. § 102 and 103 be reconsidered and withdrawn and that a formal and timely Notice of Allowance of the application be issued.

If the Examiner has any questions with respect to any matter now of record, the Applicant attorney may be reached at the telephone number below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 22-0212.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.

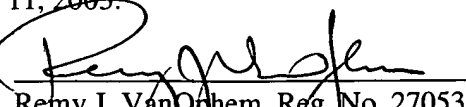

Remy J. VanOphem
Registration No. 27053

755 West Big Beaver Road
Suite 1313
Troy, MI 48084-4903
(248) 362-1210

Certificate Under 37 CFR § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 11, 2003.

Date: August 11, 2003


Remy J. VanOphem, Reg. No. 27053